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Mailed:
July 13, 2006
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Offshore Sailing School Ltd., Inc.

Serial No. 76604329

Michael A. Painter of Isaacman Kaufman & Painter for
Offshore Sailing School Ltd., Inc.

Douglas M. Lee, Trademark Examining Attorney, Law Office 107
(J. Leslie Bishop, Managing Attorney).

Before Quinn, Bucher and Grendel, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Offshore Sailing School Ltd., Inc., seeks registration
on the Principal Register of the mark **COLGATE SAILING
SCHOOL** for services recited in the application as
"conducting of classes and furnishing classroom and on-water
instruction in sailing" in International Class 41.¹

This case is now before the Board on appeal from the
final refusal of the Trademark Examining Attorney to

¹ Application Serial No. 76604329 was filed on July 28, 2004
based upon applicant's allegation of a *bona fide* intention to use
the mark in commerce. Applicant has disclaimed the words
"Sailing School" apart from the mark as a whole.

register this designation under Section 2(e)(4) of the Trademark Act, 15 U.S.C. Section 1052(e)(4), because the proposed mark is primarily merely a surname.

Applicant and the Trademark Examining Attorney submitted briefs. Applicant did not request an oral hearing. We affirm the refusal to register.

In support of the surname refusal, the Trademark Examining Attorney has made of record the following: evidence from the Lexis/Nexis USFIND online database showing the surname significance of the term COLGATE; a website excerpt from www.hamrick.com, showing the distribution of the surname COLGATE among the population in each of the fifty states; and websites showing the generic nature of the term "Sailing School" when used in connection with the involved services.

While applicant concedes that COLGATE is the surname of Steve Colgate, applicant's chairman, it argues that "the composite mark is fully capable of identifying Applicant as the source of the identified services." Applicant's brief, p. 5. Applicant cites to the decision of In re Hutchinson Technology, Inc., 852 F.2d 552, 7 USPQ2d 1490, 1492 (Fed. Cir. 1988), where the majority of the Federal Circuit panel found that HUTCHINSON TECHNOLOGY was not primarily merely a

surname inasmuch as the word "Technology" was found not to be even merely descriptive of the involved goods.

The test for determining whether a mark is primarily merely a surname is the primary significance of the mark to the purchasing public. See In re Hutchinson Technology Inc., *supra*, citing In re Kahan & Weisz Jewelry Mfg. Corp., 508 F.2d 831, 184 USPQ 421 (CCPA 1975) and In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238 (CCPA 1975). The initial burden is on the Trademark Examining Attorney to establish a *prima facie* case that a mark is primarily merely a surname. See In re Etablissements Darty et Fils, 759 F.2d 15, 16, 225 USPQ 652, 653 (Fed. Cir. 1985). After the Trademark Examining Attorney establishes a *prima facie* case, the burden shifts to the applicant to rebut this finding.

The Board, in the past, has considered several different factors in making a surname determination under Section 2(e)(4): (i) the degree of surname rareness; (ii) whether anyone connected with applicant has the surname; (iii) whether the term has any recognized meaning other than that of a surname; and (iv) the structure and pronunciation or "look and feel" of the surname. In re Benthin Management GmbH, 37 USPQ2d 1332 (TTAB 1995).

There is no doubt but that the Trademark Examining Attorney has met his initial burden of establishing that

COLGATE is primarily merely a surname. In particular, the Trademark Examining Attorney has presented evidence of several hundred COLGATE surname references from the Lexis/Nexis USFIND database, of which the first hundred were printed out. The Court of Appeals for the Federal Circuit has held that this type of evidence is sufficient to establish a *prima facie* surname case. See Hutchinson Technology, *supra*; Darty, *supra*; see also 2 J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 13.30, p. 13-50 (4th ed. 2004).

The Trademark Examining Attorney's Lexis/Nexis USFIND evidence is collected from telephone directories and address books across the country. As pointed out by the Trademark Examining Attorney, there is no magic number of directory listings required to establish a *prima facie* surname case. Even rare surnames are not registrable on the Principal Register as long as the primary significance of the term is its surname significance. In re Gregory, 70 USPQ2d 1792 (TTAB 2004); In re Cazes, 21 USPQ2d 1796, 1797 (TTAB 1991); In re Rebo High Definition Studio, Inc., 15 USPQ2d 1314 (TTAB 1990); In re Industrie Pirelli Societa per Azioni, 9 USPQ2d 1564, 1566 (TTAB 1988), *aff'd unpublished decision* No. 89-1231, 883 F.2d 1026 (Fed. Cir. 1989); In re Wickuler-Kupper-Brauerei KGaA, 221 USPQ 469, 470 (TTAB 1983); In re

Petrin Corp., 231 USPQ 902 (TTAB 1986); and In re Etablissements Darty et Fils, 222 USPQ at 261-62. Based upon several hundred COLGATE surname references in the USFIND database, we conclude that COLGATE is a relatively rare surname within the United States.²

As to the second Benthin factor, applicant concedes that COLGATE is the surname of applicant's chairman - clearly someone closely associated with applicant. Thus, based on the evidence in this record, this factor also supports a surname finding.

The third factor we consider is whether the term has a recognized meaning other than that of a surname. While the Trademark Examining Attorney argues that "there is no evidence that the term 'COLGATE' has any recognizable connotation other than as a surname," it is certainly true that applicant has failed to demonstrate that the term COLGATE has another non-surname meaning.

² We point out that the evidence in this case is more extensive than that in cases where a surname was considered rare and therefore registrable. See e.g. Kahan & Weisz, 508 F.2d at 832, 184 USPQ at 422 (six DUCHARME surname telephone directory listings); In re Sava Research Corp., 32 USPQ2d 1380 (TTAB 1994) (one hundred SAVA surname telephone directory listings); Benthin Management, 37 USPQ2d at 1333 (one hundred BENTHIN surname telephone directory listings); In re Garan, Inc., 3 USPQ2d 1537 (TTAB 1987) (six GARAN telephone directory listings and one NEXIS listing). In re United Distillers plc, 56 USPQ2d 1220 (TTAB 2000) [single listing of HACKLER in the Manhattan directory and three unique listings in Washington DC metro directories].

Finally, we consider whether the word COLGATE has the structure and pronunciation - or the "look and feel" - of a surname. In re Industrie Pirelli, 9 USPQ2d at 1566. If a term does not have the look and feel of a surname, such that consumers are likely to view it as something other than a surname, it would not be primarily merely a surname. On this factor, it is our view that "Colgate" would be perceived only as a surname inasmuch as it has the unmistakable structure of an English habitational name. This contrasts with In re United Distillers plc, *supra*, where we found that the word HACKLER would not be perceived as primarily merely a surname because it does not have the clear "look and feel" of a surname.

Thus, reviewing the evidence of record as to all of the Benthin factors, we find that applicant has failed to rebut the Trademark Examining Attorney's *prima facie* surname case.

Applicant has argued in its brief that it is applying for a composite mark where the non-surname wording is "capable," and hence, when this composite mark is taken as a whole, it is not primarily merely a surname. Applicant's appeal brief, pp. 2 - 5. However, the Trademark Examining Attorney argues in response, that "the inclusion in a mark of the generic name for the services does not overcome its

surname significance." Trademark Examining Attorney's brief, p. 3.

The Trademark Examining Attorney and applicant both refer to the Section 1211.01 of the Trademark Manual of Examining Procedure, the relevant portion of which is reproduced below:

TMEP § 1211.01(b)(vi) Surname Combined with Wording

The treatment of marks that include wording in addition to a term that, standing by itself, is primarily merely a surname, depends on the significance of the non-surname wording.

If the wording combined with the surname is incapable of functioning as a mark (i.e., a generic name for the goods or services), the examining attorney should refuse registration on the ground that the entire mark is primarily merely a surname under §2(e)(4). If the policy were otherwise, one could evade §2(e)(4) by the easy expedient of adding the generic name of the goods or services to a word that is primarily merely a surname. *In re Hamilton Pharmaceuticals Ltd.*, 27 USPQ2d 1939 (TTAB 1993) (HAMILTON PHARMACEUTICALS for pharmaceutical products held primarily merely a surname); *In re Cazes*, 21 USPQ2d 1796, 1797 (TTAB 1991) (BRASSERIE LIPP held primarily merely a surname where "'brasserie' is a generic term for applicant's restaurant services"); *In re Woolley's Petite Suites*, 18 USPQ2d 1810 (TTAB 1991) (WOOLLEY'S PETITE SUITES for hotel and motel services held primarily merely a surname); *In re Possis Medical, Inc.*, 230 USPQ 72, 73 (TTAB 1986) (POSSIS PERFUSION CUP held primarily merely a surname, the Board finding that "[a]pplicant's argument that PERFUSION CUP is not a generic name for its goods ... is contradicted by the evidence the Examining Attorney has pointed to"); *In re E. Martinoni Co.*, 189 USPQ 589, 590-91 (TTAB 1975) (LIQUORE MARTINONI (stylized) for liqueur held primarily merely a surname, with "liqueure" being the Italian word for "liqueur")

As noted in the above-quoted TMEP discussion, if the additional wording in a surname composite mark is generic, the general rule set out in by the CCPA in *Kahan & Weisz Jewelry* and *Harris-Intertype* will continue to be applied in

the wake of Hutchinson Technology, provided in such cases that the additional matter is generic (e.g., "brasserie," "pharmaceuticals," "petite suites," "perfusion cup," "liquore," etc.). Similarly, the Trademark Examining Attorney has demonstrated from the following websites that "the wording 'SAILING SCHOOL' is generic for an institute for instruction in the field of sailing." Screen prints attached to Office action of May 16, 2005.

MARINER SAILING SCHOOL

Belle Haven Marina • Alexandria, Virginia • 703-768-0018

Sailing Instruction & Boat Rentals in Alexandria



Founded in 1975, the Mariner Sailing School in Alexandria, Virginia has become the largest full time Sailing School in the Washington, D.C. area. Our school is owned and operated by sailors, and offers a full range of [Sailing Instruction](#) and [Boat Rentals](#). Former students' recommendations continue to be our best advertising.

Small class sizes, skilled Instructors, free practice time, 1/2 price weekday rentals, great boats and a convenient location are just a few of the reasons to give us a call.

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Sailing School

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Chesapeake Bay and Caribbean, ASA Gold Star Award Winning School.
[www.UpperBaySailing.com](#)

[Sailing Lessons at DCSail](#)

Community Sailing in DC, affordable Lessons, Boat Rentals, and Racing
[www.dcsail.org](#)

[Tradewinds Sailing School](#)

Best Sailing School on S.F. Bay Top Instructors, New Boats
[www.TradewindsSailing.com](#)

[ASA Sailing School](#)

Get Certified! Caribbean, BVI-USVI, Bahamas, Pacific NW, Offshore.
[www.OnceASailing.com](#)

Sailing School - Featured Links

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Download US SAILING Brochure on [The First Thing to Look For in a Sailing School](#)

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³ <http://www.saildc.com>

⁴ <http://www.netboating.com/sailing-school.htm>

⁵ <http://www.sailingusa.info>

New York Sailing School

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Train & Bus Schedule
Road Directions
Other Sailing Schools

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Accordingly, applicant has taken a surname and created a composite mark by adding the generic name of the involved services. However, such a combined term is still primarily merely a surname.

Decision: The refusal to register the term **COLGATE SAILING SCHOOL** under Section 2(e)(4) of the Lanham Act is hereby affirmed.

⁶ <http://www.nyss.com>